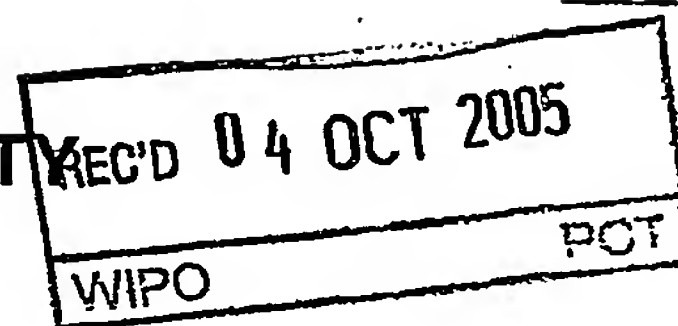


# PATENT COOPERATION TREATY



From the  
INTERNATIONAL SEARCHING AUTHORITY

## PCT

To:

see form PCT/ISA/220

### WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

**FOR FURTHER ACTION**  
See paragraph 2 below

International application No.  
PCT/EP2004/006905

International filing date (day/month/year)  
13.05.2004

Priority date (day/month/year)  
26.06.2003

International Patent Classification (IPC) or both national classification and IPC  
G06F17/24, G06F17/30

Applicant  
INTERNATIONAL BUSINESS MACHINES CORPORATION

#### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

#### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

#### 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



European Patent Office - Gitschiner Str. 103  
D-10958 Berlin  
Tel. +49 30 25901 - 0  
Fax: +49 30 25901 - 840

Authorized Officer

Woods, J

Telephone No. +49 30 25901-677



**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2004/006905

---

**Box No. I Basis of the opinion**

---

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material:  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing:  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2004/006905

---

**Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

---

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-18
Inventive step (IS)	Yes: Claims	
	No: Claims	1-18
Industrial applicability (IA)	Yes: Claims	1-18
	No: Claims	

2. Citations and explanations

**see separate sheet**

---

**Box No. VII Certain defects in the international application**

---

The following defects in the form or contents of the international application have been noted:

**see separate sheet**

**Re Item V.**

1 Reference is made to the following document:

D1 : US 2001/053252 A1 (CREQUE STUART) 20 December 2001 (2001-12-20)

**2 INDEPENDENT CLAIM 1**

2.1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT.

Document D1 discloses (the references in parentheses applying to this document):

A method for composing an electronic document from the content of one or a plurality of parts of one or a plurality of physical documents selected by a user, (abstract; claim 14; figure 1)

said method comprising the step of:

creating, for each selection made by the user, a record in a table, said record comprising means for associating a part selected by the user with its electronic copy, said step, for use in a computer device, ([0027]-[0034]; [0048])

comprising the further steps of: for each selected document:

receiving means identifying the document selected by the user; ([0027-0034])

receiving means for accessing an electronic copy of said document; ([0019]; 0049))

receiving means identifying one or a plurality of pages selected by the user of a physical copy of said document, said physical document comprising one or a plurality of pages; ([0071])

for each selected page :

receiving means defining on the selected page, one or a plurality of parts selected by the user; ([0067])

for each selected part:

'storing said means defining the selected part in a selections table ; 'associating in said selections table, said means defining the selected part with: 'said means identifying the selected document; 'said means identifying the selected page; 'said means for accessing the electronic copy of said document. ([007]; [0020-0037])

These are all of the features of independent claim 1; therefore the subject matter of independent claim 1 is not new.

### **3 INDEPENDENT CLAIM 17**

3.1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 17 is not new in the sense of Article 33(2) PCT.

Document D1 discloses:

A computer device comprising means adapted for carrying out the steps of the method according to any one of the preceding claims. (claim 1 and references cited w.r.t. claim 1).

This is the only feature of claim 17; therefore the subject matter of independent claim 17 is not new.

### **4 INDEPENDENT CLAIM 17**

4.1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 18 is not new in the sense of Article 33(2) PCT.

Document D1 discloses:

A computer device comprising means adapted for carrying out the steps of the

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/EP2004/006905

method according to any one of the preceding claims. (claim 1 and references cited w.r.t. claim 1).

This is the only feature of claim 18; therefore the subject matter of independent claim 18 is not new.

**5 DEPENDENT CLAIMS 2-16**

Dependent claims 2-16 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step (Article 33(2) and (3) PCT).

The additional features of the following claims are disclosed by the corresponding references to D1: claim 2 ([0044]; [0052]; [0055]), 3 ([0038], [0044], [0052], [0059]), 4 [0052], 5 ([0027]-[0031]; [0035]; [0049]; claim 5), 6 ([0071]), 9 (figure 1), 10 (figure 1), 11 ([0037]), 12 ([0037]; [0039]), 13 (abstract, [0011]; [0026]-[0034], [0049]; [0071]; [0073]), 14 ([0071]), 15 ([0059]), 16 ([0075]).

Therefore the subject matter of claims 2-6 and 9-16 is not new.

D1 (see references above for claim 5) discloses a network, a network address and a server, the standard types used by the skilled person would be an IP network, a URL and a web server, therefore, although the terms are not explicitly mentioned in D1, it is clear that these are implied in the disclosure.

In D1 HTML is considered, but PDF is chosen instead, that is to say the use of HTML is known.

Therefore, the subject matter of claim 7 is not inventive.

Clearly, the user's computer may or may not be connected to the network or not; therefore, the subject matter of claim 8 is not new.

**Re Item VII.**

Given that the network, network address and server of claim 7 are first mentioned in claim 5, claim 7 cannot depend on claims 1-4 and it should thus be reformulated as a claim

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)**

---

International application No.

**PCT/EP2004/006905**

dependent on claim 5.